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P.O. Box 272400  
Fort Collins, CO 80527-2400

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RIES, LAURIE ANNE	
ART UNIT	PAPER NUMBER
2176	

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/025,043  
Filing Date: December 18, 2001  
Appellant(s): HENRY, STEVEN G.

**MAILED**

**MAR 02 2007**

**Technology Center 2100**

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Bruce E. Dahl, Esq.  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 28 November 2006 appealing from the Office action mailed 17 August 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,693,966	MITCHELL	10-1999
6,295,543	BLOCK	09-2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-12, 14-22, 24-27, and 29-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitchell (U.S. Patent 5,693,966).

**Regarding claims 1, 15, 29, and 34,** Mitchell teaches a method for accessing network data associated with a document (See Mitchell, Figure 3) comprising:

Converting at least a portion of said document to electronic format with a digital capture input device (See Mitchell, Figure 5, element Scan, wherein paper document is scanned. It is inherent that a scanner is used which is a digital capture input device),

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the at least a portion of said document having one or more indicia thereon (See Mitchell, Figure 2, element Indexing on portion of document. Also see Column 2, lines 60-65)  
the digital capture input device being operatively associated with a network (Since data is converted in to electronic format accessible by network or Internet as described in the Abstract, lines 1-3, it is inherent that scanner is operatively associated with network)

Analyzing the at least a portion of said document in electronic format to obtain said one or more indicia (See Mitchell, Figure 2, element Indexing. Also see Column 2, lines 60-65, wherein indexing information is obtained)

Using said one or more indicia to locate said network data, network data not including said document (See Mitchell, Figure 4, specifically, Column 7, lines 15-20, 32-37, and 47-54, wherein Mitchell teaches a table of contents in a document represented as hyperlinks and those hyperlink documents can also be viewed. Hyperlinks within the document are considered as additional network data other than document, which is consistent with applicant's specification on Page 5, lines 1-14, wherein additional network data can be forms or coupons. It is inherent that forms or coupons are documents with hyperlinks within the documents) said network data being maintained at another device operatively associated with the network (See Mitchell, Figure 2, element Processing Environment, wherein a network data is obtained and

Automatically accessing said network data (See Mitchell, Figure 3, element User accessing and retrieving networking information. Network data can be accessed automatically as described in Mitchell, Column 7, lines 32-35). It is inherent that network data is located on a network server (another device).

**Regarding claims 2, 17, and 31,** Mitchell teaches the claimed invention of indexing comprising portion of text and document as described in Column 2, lines 60-67, wherein Mitchell teaches indexing schemes to retrieve pages containing graphics and text as described in Column 2, lines 67- Column 3, lines 10, and as shown in Figure 2, element Tagged version text/graphics.

**Regarding claims 3, 18, and 32,** Mitchell teaches the claimed invention of providing the at least a portion of said document with one or more tags before the at least a portion of said document is converted to electronic format with said digital capture input device; analyzing the at least a portion of said document in electronic format to obtain said one or more tags; and

Using said one or more tags to locate said network data (See Mitchell, Figure 2, wherein a portion of the document is tagged before being converted into electronic format. Portion is indexed which is equivalent to analyzing to obtain tag information and to obtain network data. Also see Mitchell, Column 3, lines 1-10.

**Regarding claims 4, 19, and 33,** Mitchell teaches HTML tags. It is inherent tags are HTML tags which are machine readable as claimed.

**Regarding claims 5, 6, 10, 20, 21, and 25**, Mitchell teaches the claimed invention of receiving network data at user or input device as shown in Mitchell, Figure 3, element User Display.

**Regarding claims 7 and 22**, Mitchell teaches the claimed invention of printing network data as described in Mitchell, Column 2, lines 30-34. Also see Mitchell, Figure 15, which describes printing at different resolutions.

**Regarding claims 9 and 24**, Mitchell teaches the claimed invention of receiving data at network device as described in Mitchell Abstract, lines 1-3.

**Regarding claims 11 and 26**, Mitchell teaches the claimed invention of sending portion of document from scanner to user as shown in Mitchell, Figure 3

**Regarding claims 12 and 27**, Mitchell teaches obtaining one or more indicia using character recognition as shown in Mitchell, Figure 2, element Indexing and OCR. OCR is also shown in Mitchell, Figure 3.

**Regarding claims 14, 16, and 30**, Mitchell teaches scanning as described above. It is inherent that scanner is multi-function device with scanning and converting functions.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell (U.S. Patent 5,693,966).

**Regarding claims 8 and 23**, Mitchell teaches the claimed invention as described above with respect to claim 1. Mitchell teaches receiving network data through the Internet as described in Mitchell, Abstract, lines 1-3. However, Mitchell fails to teach receiving as e-mail. E-mail is received through the Internet as is well known in the art. An official notice is taken. Therefore it would have been obvious for a person with ordinary skill in the art at the time of the invention to incorporate well-known method of receiving data with e-mail in the method of Mitchell because it provides customized data.

Claims 13 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell (U.S. Patent 5,693,966) in view of Block (U.S. Patent 6,295,543).

**As per claims 13 and 28**, Mitchell teaches the claimed invention as described above with respect to claim 1. Mitchell fails to teach determining frequency for each of



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one or more words, comparing the frequency to word frequency list and using a result to locate network data. However, Block does. Specifically, Block teaches the claimed invention of determining frequency for each of one or more words (See Block, Figure 3, element Frequency calculation. Also see Block, Column 3, lines 45-55) comparing the frequency to word frequency list and using a result to locate network data (Block teaches calculating correlation between word and class based on frequency, which is interpreted equivalent to claimed comparison).

Therefore it would have been obvious for a person with ordinary skill in the art at the time of the invention to incorporate frequency calculation in the method of Mitchell because it provides relevance data for classification purposes, which is desired.

#### **(10) Response to Argument**

Appellant argues in the Opening statement on Page 12 of the Brief and on Pages 20-21 of the Brief that Mitchell's hyperlinks do not comprise "network data" in the context of the pending claims. Appellant further states that the additional information or network data specified in the written description includes price options, specifications, coupons, purchase order forms, purchase incentives, company information, and warranties (See Brief, Page 20). The Office respectfully disagrees and notes that the above listed types of additional information or network data are described in the Instant Specification only as examples of such additional information (See Instant Specification, Page 3, lines 12-15), therefore it would have been inherent to conclude that other types

of data exchanged via a network may be defined as “network data” in the context of the Instant Application. Mitchell discloses network data that includes one of the exemplary types presented in the Instant Specification, such as hyperlinks to **company information** in the form of technical manuals (See Mitchell, Figure 4).

Appellant argues on Pages 14-16 and 20 of the Brief that Mitchell fails to disclose that the network data includes links used to retrieve additional information relating to the document and not included within the document. The Office respectfully disagrees. Mitchell discloses that the hyperlinks may be to locations within the document **as well as** links to **other pages or HTML documents** (See Mitchell, Column 7, lines 51-52). This is also emphasized in the drawings of Mitchell, specifically, Figure 4, which shows a Table of Contents page located at the URL address:

[http://www.cybernet.com/~ganz/letm\\_index.html](http://www.cybernet.com/~ganz/letm_index.html). Note that the page lists a link to “Phase 1 Work Plan”, identified as Part 3 within the document. Mitchell also shows the “Phase 1 Work Plan” in Figure 7, which is located at a **different** URL address and is therefore a **different** document: [http://www.cybernet.com/~ganz/pages/page6\\_op.html](http://www.cybernet.com/~ganz/pages/page6_op.html).

It is inherent that the data contained in the two separate documents is accessed via a network (i.e. the Internet) and therefore comprises “network data not including said document” and located at another device, such as a network server providing company information contained within technical manuals.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the frequency calculations of Block with the method of Mitchell providing the benefit of producing data relevant to the classification of information.

In response to applicant's argument that Block uses word frequency calculations for a different purpose, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

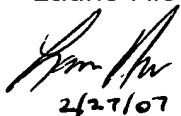
#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

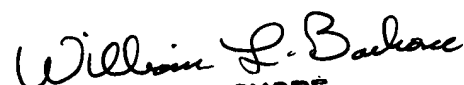
Laurie Ries

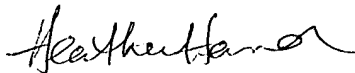


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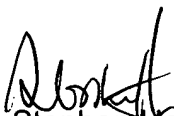
Conferees:

William Bashore

  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**



Heather Herndon



Stephen Heng